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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,492	02/27/2006	Nobuo Naito	127199	3472
25944 7590 08/04/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
08/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/569,492

Applicant(s)

NAITO ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 6-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Introduction

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendments and remarks filed on 6/15/2009 have been entered. Claim 4 has been amended. Claims 4 and 5 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Election/Restrictions

4. Applicants argue at Remarks page 6:

"Applicants again traverse the Election of Species Requirement on the ground that the genetic claims are not so broad as to place an undue burden on the Patent Office to search and examine the full scope of the claims. Rather, Applicants respectfully assert that search and examination of the entire application could be conducted without undue burden on the Examiner, thus avoiding delay and expense to Applicants. Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the genetic claims."

However, the embodiments are patentably distinct in structure and/or composition. Absence of any evidence that these embodiments are obvious variants, each embodiment requires additional

search and deemed to be burdensome. Further, applicants have correctly recognized that upon allowance of a patentable generic embodiment, a rejoinder to species will be considered. The restriction requirement is maintained.

Rejections Based on Prior Art

5. Claims 4 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshikawa et al. [US 6090473].

Yoshikawa's invention relates to an electromagnetic wave shielding and light transmitting plate suitable for a front filter of a plasma display panel [col. 1, ll. 8-10]. Fig. 6a illustrates an embodiment of the filter comprising successively an antireflective layer 65, a transparent substrate 62A, and an adhesive layer 64 [col. 17, ll. 15-22]. The adhesive layer may include small amounts of ultraviolet absorbing agent, infrared absorbing agent, and coloring agent, etc. [col. 11, ll. 19-22].

For claims 4 and 5, since Yoshikawa teaches that various ultraviolet absorbing agent, infrared absorbing agent, and coloring agent, etc., may be included in the adhesive layer, it reads on the unwanted light shielding layer, and also reads on both the near infrared (a segment of infrared) layer and the specific-wavelength-light (e.g., UV) absorbing layer. Further, since the filter is inherently transparent for viewing the plasma display, the base resin for forming the adhesive layer is necessarily transparent as well. Regarding the functional languages of the infrared absorbing agent and the coloring agent, they are deemed either anticipated, or obviously provided by practicing the invention of prior art, dictated by the same required light filtering properties for the same end use as the claimed invention. Regarding newly amended structural

limitation "a specific-wavelength-light absorbing layer laminated to the near infrared rays absorbing layer on the side opposite to the transparent substrate film and outside the near infrared rays absorbing layer", it is interpreted as reciting two discrete layers of "near infrared absorbing layer" and "specific-wavelength-light absorbing layer". However, since Yoshikawa's single light absorbing adhesive layer reads on both layers of the claimed invention, e.g., each side of Yoshikawa's light absorbing adhesive layer reads on one of the layer of the two-layer structure of the claimed invention, the amendment fails to exclude Yoshikawa's invention. Further, the examiner takes Official notice that applying successive layers of light absorbing layer is common and well known to one of ordinary skill in the art of light filter. Absence of any unexpected results, it would have been an obvious choice to apply sequential layers of light filtering layers, because it is *prima facie* to select alternative equivalent known art for the same end use.

Double Patenting

6. Claims 4 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/562424. Although the conflicting claims are not identical, they are not patentably distinct from each other because they obviously read on each other as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 4 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No.

10/569512. Although the conflicting claims are not identical, they are not patentably distinct from each other because they obviously read on each other as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

8. Applicants argue at Remarks page 7:

“Yoshikawa thus teaches that the light absorbing materials are contained in the same layer, not in two separate, laminated layers as claimed. Yoshikawa thus does not anticipate the claimed invention.”

However, since Yoshikawa’s single light absorbing adhesive layer reads on both layers of the claimed invention, e.g., each side of Yoshikawa’s light absorbing adhesive layer reads on one of the layer of the two-layer structure of the claimed invention, the amendment fails to exclude Yoshikawa’s invention. Further, the examiner takes Official notice that applying successive layers of light absorbing layer is common and well known to one of ordinary skill in the art of light filter. Absence of any unexpected results, it would have been an obvious choice to apply sequential layers of light filtering layers, because it is *prima facie* to select alternative equivalent known art for the same end use.

Applicants argue at page 10:

“In contrast, Yoshikawa does not provide for easy and secure adjustment of the transmittance and color tone correction properties. In Yoshikawa, adjustment of these properties necessarily affects the near infrared rays absorbing layer. Adjustment of the properties thus also requires adjustment of the near infrared rays absorbing layer. Yoshikawa does not teach or suggest, and provides no reason or rationale for, modifying its unitary structure to instead provide two separate laminated layers, in the manner as claimed.”

However, no evidence whatsoever has been provided that proper adjustment of transmittance and color tones are unattainable by Yoshikawa's invention. Applicants' unsupported argument in vacuum is unpersuasive.

Applicants argue at page 11

"Because co-pending Applications Nos. 10/562,424 and 10/569,512 have not issued, filing a Terminal Disclaimer to obviate a provisional double-patenting rejection is premature. See MPEP §706.02(k). Applicants respectfully request abeyance of the double patenting rejections."

However, double patenting over copending applications are proper, applicants' argument is mistaken. Further, there is no such rule in MPEP for holding double patenting in abeyance. The ODB rejections are maintained.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794